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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/015,996

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Stephen Carter

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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

12/16/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/015,996	<b>Applicant(s)</b> CARTER, STEPHEN	
	<b>Examiner</b> Stephen M. D'Agosta	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12, 14-18 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 14-18 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

1. A new rejection is found attached.
2. The examiner notes that the term “**about**” in claims 3, 15, 28 and 31 can be interpreted as indeterminant and should be modified. A USC 112 2<sup>nd</sup> paragraph will be put forth before any allowance should this term not be modified.
3. New claim 30 has USC 101 and USC 112 issues as noted below.
4. A **more favorable outcome may occur** if the applicant were to amend each independent claim as follows:

Claim 1 + claim 2 + claim 4 + (claim 5 or 6)

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 30:** the claimed invention is directed to non-statutory subject matter. The claim must use language that empirically links the program and processor/medium together. Suggested examples are:

Examples of acceptable language in computer-processing related claims :

1. “computer readable medium” encoded with \_\_\_\_\_
  - [a] “a computer program”
  - [b] “software”
  - [c] “computer executable instructions”
  - [d] “instructions capable of being executed by a computer”
2. “a computer readable medium” \_\_\_\_\_ “computer program”
  - [a] storing a
  - [b] embodied with a
  - [c] encoded with a
  - [d] having a stored
  - [e] having an encoded

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 30** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant's specification makes reference to non-statutory medium/program embodiments such as waves, signals, etc.. The applicant should either be a) delete this phrase and/or b) put forth a statement that the phrase is not meant to encompass the program as being a signal, carrier wave, transmission, etc. which is non-statutory:

*Those of skill of the art would further appreciate that the data, instructions, commands, information, signals, bits, symbols, and chips that may be referenced throughout the above description are advantageously represented by voltages, currents, electromagnetic waves, magnetic field or particles, optical fields or particles, or any combination thereof. (Para #53).*

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 5, 11-12, 14-15, 27-28 and 30-31** rejected under 35 U.S.C. 103(a) as being unpatentable over Salihi and further in view of Walter and Mannisto.

As per **claims 1, 11-12, 28 and 30-31**, Salihi teaches a system of operating a wireless handset capable of making clear calls , and secure calls (Abstract teaches encrypted or unencrypted calls), a method comprising:

determining whether the handset is in the traditional mode, or in an autosecure mode, or in a secure-only mode (figure 2 shows a switch which provides control to the phone for putting it into one of two modes and inherently allows the phone to determine its current mode. One skilled would also inherently provide “feedback”, perhaps on the display of the phone, of this mode to the user such that it allows them to also understand which mode the phone is in for easy operation, eg. don’t get confused);

sending a confirmation request to originate a clear call and receiving a request confirmation (Salihi teaches use of a confirmation request/receipt, See Abstract, to ensure both the device and network are in the proper mode – also see figure 3a which describes the coded/uncoded request and confirmation)

**but is silent on**

pressing a key for a predetermined amount of time;

if the handset is currently in autosecure mode, either the secure-only or the autosecure mode, originating a secure call mode if the key is held for a time period greater than the predetermined amount of time, and originating a clear call if the key is held for a time period less than the predetermined amount of time; and

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if the handset is currently in the traditional mode, originating in a clear call if the key is held for a time period greater than the predetermined amount of time, and originating a secure call if the key is held for a time period less than the predetermined amount of time.

As stated in the opening remarks, the difference between the claims and Salihi is the "design" which changes the phone from one mode to another. Salihi is a simple switch (which might be a added button on the phone) while the applicant chooses to use a timed button-press to switch. Another option would be to use a soft-key and/or specific menu option (eg. says "change to xyz mode"). Therefore, a considerable amount of the claim is directed to a design choice and/or automation (eg. one button press).

Previously presented art, **Walter**, teaches a wireless telephone system for security where a keypad 152 includes a switch or other means, such as a pushbutton, for allowing the user to activate a secure transmission mode (see column 5, lines 34-37).

Also presented previously, **Mannisto** discloses a system where in order to set a keyboard lock, a user depresses and holds the key for a given delay period. If the button is not pressed for a certain amount of time, the phone does not enter the keyboard lock state (see column 2, line 62 - column 3, line 3). Further, if the phone is in the auto-locked state, only the unlock sequence will register in the phone once it is locked (see column 3, lines 35-45), satisfying the condition of "unless the handset is currently in either secure-only mode or auto secure mode."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Walter et al with Mannisto so that the holding of the key sets the secure mode in order to avoid the need for a separate key which takes up space in the keypad and increases manufacturing costs as suggested by Mannisto (see column 1, lines 60-61 ).

***With further regard to claim 11***, both Salihi and Walter teach a process to "smoothly transition" from a first mode call to a second mode call (eg. from un-secure to

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secure) – See Salihi figure 3a and Walter figure 3, eg. both teach selecting and responding to a call request in a certain mode.

**With further regard to claim 30,** the prior art all teach embodiments using a wireless device with computer processor and program that performs the steps taught.

Regarding **claim 2**, the combination of Walter et al and Mannisto discloses a system where a PIN is used to unlock the security features (see Walter et al column 4, lines 50-52 and column 7, lines 6-10 and figure 3).

Regarding **claims 3 and 28, 31**, the combination of Walter et al fails to disclose the predetermined amount of time is about two seconds. In a similar field of endeavor, Mannisto discloses a system where a suitable delay for the key to be pressed and held down for is roughly 0.5-2 seconds (see Mannisto column 3, line 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Walter et al with Mannisto so that the holding of the key sets the secure mode in order to avoid the need for a separate key which takes up space in the keypad and increases manufacturing costs as suggested by Mannisto (see column 1, lines 60-61 ).

Regarding **claim 5**, the combination of Walter et al and Mannisto discloses that after the phone is powered on, the user unlocks it by entering a PIN (see Walter et al column 7, lines 6-10 and figure" 3), which reads on the claimed "the step of entering a PIN number is entered each time the handset is activated"

Regarding **claim 14**, the combination of Walter et al and Mannisto discloses a system where a PIN is used to unlock the security features (see Walter et al column 4, lines 50-52 and column 7, lines 6-10 and figure 3), which reads on the claimed "entering a personal identification number (PIN) to register as a secure user".

Regarding **claim 15**, Walter et al fails to expressly disclose the predetermined amount of time is about 2 seconds. In a similar field of endeavor, Mannisto discloses a system where a suitable delay for the key to be pressed and held down for is roughly 0.5-2 seconds (see Mannisto column 3, line 3). Regarding claim 17, the combination of Walter et al and Mannisto discloses that after the phone is powered on, the user unlocks it by entering a PIN (see Walter et al column 7, lines 6-10 and figure 3), which reads on the claimed "the step of entering a PIN number is entered each time the handset is activated".

**Claims 4, 16 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al in view of Mannisto as applied to claim 1 above, and further in view of Alanara et al (US005845205A).

Regarding **claims 4, 16 and 29, 32**, , the combination of Walter et al and Mannisto fails to expressly disclose that the key pressed down is the send/talk key.

In a similar field of endeavor, Alanara et al discloses a phone system where a function is assigned to holding down the "send" key (see column 3, lines 50-61). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al and Mannisto so that the send key is held down in order to provide a more intuitive interface.

**Claims 6, 7, 8 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al and Mannisto as applied to claim 2 above, and further in view of Harris et al (US006442406B1).

Regarding **claims 6 and 18**, the combination of Walter et al and Mannisto fails to expressly disclose the disabling of the telephone if the PIN is incorrectly entered a number of times. In a similar field of endeavor, Harris et al discloses a system requiring entry of a code to change operating parameters (see column 1, lines 60-67), but when the code entry is not correct a conventional lockout routine is executed (see column 1, line 67 - column 2, line 6), which reads on the claimed "disabling the handset if the PIN number is incorrectly entered more than a predetermined number of times".



It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al and Mannisto to include the above disabling of the telephone if the PIN is entered incorrectly a number of times in order to enhance the security of the device by making it more difficult for an unauthorized user to break the code.

Regarding **claim 7**, the combination of Walter et al, Mannisto and Harris et al discloses between 3 and 5 tries as an exemplary number of incorrect entries (see Harris et al column 2, lines 2-6). The combination of Walter et al, Mannisto and Harris et al fails to expressly disclose 7 as the number of tries for entering a PIN however this difference is not critical to the invention and would not render the claimed invention patentable over the disclosed invention because both provide the end result of preventing an unauthorized user from the functions the PIN is protecting. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al, Mannisto and Harris et al such that the phone is disabled after 7 incorrect PIN entries in order to further prevent an unauthorized user from gaining access to the functions the PIN is protecting.

Regarding **claim 8**, the combination of Walter et al, Mannisto fails to expressly disclose that the predetermined number of times is 3. In a similar field of endeavor, Harris et al discloses between 3 and 5 tries as an exemplary number of incorrect entries (see Harris et al column 2, lines 2-6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al and Mannisto to include the above disabling of the telephone if the PIN is entered incorrectly a number of times in order to enhance the security of the device by making it more difficult for an unauthorized user to break the code.

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### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen M. D'Agosta/  
Primary Examiner, Art Unit 2617